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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,964	11/17/2003	Norihiro Edwin Aoki	AOL0132	5404
22862	7590	06/01/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			CALDWELL, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2129	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/715,964		AOKI, NORIHIRO EDWIN	
	Examiner		Art Unit	
	Michael Caldwell		2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 17th, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20, 22-32 and 34-36 is/are rejected.
- 7) ☒ Claim(s) 9, 21 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>September 13, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to application 10/715,964 filed November 17th, 2003. Claims 1-36 have been examined.
2. Receipt is acknowledged of papers submitted April 12th, 2004: Response to pre-exam formalities, including declaration pursuant to 37 C.F.R. 1.63
3. The Information Disclosure Statement (IDS) submitted on September 13th, 2004 in compliance with the provisions of 37 C.F.R. 1.97. Accordingly, the IDS is being considered by the examiner.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-5, 10, 13-17, 22, 25-29, and 34** are rejected under 35 U.S.C. 102(b) as being anticipated by Creswell et al. (US Patent 6,564,264, herein referred to as Creswell). Examiner suggests applicant review the entire teaching of Creswell, as its entire teachings have been relied upon. When referring to a column and line number of the reference, the following nomenclature is used: CX, LY-Z representing column X, lines Y-Z.

Regarding claim 1, Creswell teaches a process for updating (C 4, L 24-30) electronic information in a computer environment (C 2, L 21-34), comprising the steps

of: automatically (C 4, L 1-7) inspecting a message that is to be delivered to a first address (first address is the sending user's address whose message has been returned) upon receiving the message (C 4, L 4-30) to determine whether the message contains information about a status of a second address (C 4, L 24-30, where the status is the reasoning behind the returning the sender's message), and in response to a determination that the message contains information about the status of the second address, updating a record for the second address in a database (C 4, L 24-30, wherein the database is the collection of entries of contact information a user has access to, constituting an address book).

Regarding claim 2, Creswell teaches storing the message at the first address for retrieval by a first user at the first address (C 3, L 30-36, first user is a sender of email, where the user's information such as contacts, history and particularly messages, are stored remotely for user retrieval, the basis for server-client model applied to email, as is well known in the art through free email services such as MSN's Hotmail or Yahoo!).

Regarding claim 3, Creswell teaches the record is a portion of an address book of the first user in the database (C 4, L 24-30).

Regarding claim 4, Creswell teaches the status indicates a permanent error (a message being returned for an incorrect address is a permanent error) in delivering a message to the second address (C 4, L 4-8); and said updating is according to a user preference (C 4, L 30-39).

Regarding claim 5, Creswell teaches transparently removing the second address from the address book (C 4, L 26-30, wherein the "yes" condition does not have to ask

for user intervention [i.e. doing so transparently] of the replacement, and therefore removal, of the second address from the user's address book).

Regarding claim **10**, Creswell teaches the second address comprises one of: an address for electronic mails; an address for a web page; and a phone number (C1, L 16 through C 2, 25; Figure 1).

Regarding claim **13**, Creswell teaches an apparatus for updating address information in a computer environment (C 2, L 21-25), comprising: a module for receiving a message that is to be delivered to a first address; a module for automatically inspecting the message to determine whether the message contains information about a status of a second address (C 4, L 4-7); and a module for updating a record for the address in a database (C 4, L 26-30, wherein the database is the collection of entries of contact information a user has access to, constituting an address book), in response to a determination that the message contains information about the status of the second address (C 4, L 24-26),.

Regarding claim **14** Creswell teaches a module for storing the message at the first address for retrieval by a first user at the first address (C 1, L 35-36).

Regarding claim **15**, Creswell teaches the record is a portion of an address book of the first user in the database (C 4, L 26-30).

Regarding claim **16**, Creswell teaches the status indicates a permanent error in delivering a message to the second address (C 4, L 4-8); and the record is updated according to a user preference (C 4, L 30-39).

Regarding claim **17**, Creswell teaches a module for transparently removing the second address from the address book (C 4, L 26-30, wherein the "yes" condition does not have to ask for user intervention [i.e. doing so transparently] of the replacement, and therefore removal, of the second address from the user's address book).

Regarding claim **22**, Creswell teaches the second address comprises one of: an address for electronic mails; an address for a web page; and a phone number (C1, L 16 through C 2, 25).

Regarding claim **25**, Creswell teaches A program storage medium readable by a computer, tangibly embodying a program of instructions executable by the computer to perform a method for updating address information in a computer environment (C 2, L 21-25), the method comprising the steps of: receiving a message that is to be delivered to a first address (C 4, L 4-7); automatically inspecting the message to determine whether the message contains information about a status of a second address (C 4, L 24-26); and in response to a determination that the message contains information about the status of the second address, updating a record for the address in a database (C 4, L 26-30, wherein the database is the collection of entries of contact information a user has access to, constituting an address book).

Regarding claim **26**, Creswell teaches storing the message at the first address for retrieval by a first user at the first address (C 1, L 35-36).

Regarding claim **27**, Creswell teaches the record is a portion of an address book of the first user in the database (C 4, L 26-30).

Regarding claim **28**, Creswell teaches the status indicates a permanent error in delivering a message to the second address (C 4, L 4-8); and said updating is according to a user preference (C 4, L 30-39).

Regarding claim **29**, Creswell teaches transparently removing the second address from the address book (C 4, L 26-30, wherein the "yes" condition does not have to ask for user intervention [i.e. doing so transparently] of the replacement, and therefore removal, of the second address from the user's address book).

Regarding claim **34**, Creswell teaches the second address comprises one of: an address for electronic mails; an address for a web page; and a phone number (C1, L 16 through C 2, 25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **6-7, 12, 18-19, 24, 30-31, and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Creswell as applied to claims 1-4 above, and further in view of Sommerer (US Pre Grant Publication 2002/0143879).

Creswell teaches a process for updating (C 4, L 24-30) electronic information in a computer environment (C 2, L 21-34), but does not explicitly teach the steps of

replacing the second address in the address book with a comment which indicates that it is undeliverable to the second address as claimed in claims **6, 18, and 30**.

Sommerer teaches the claimed replacing of the second address in the address book with a comment which indicates that it is undeliverable to the second address (Paragraph [0036]-[0038], the flag existing to comment on the undeliverability of a message to the second address, maintained in the address book for automatic intervention of future messages sent to the potentially expired second address)

Being from the same field of endeavor, automatic updating for purposes of saving a user's time and effort, it would have been obvious to one of ordinary skill at the time of applicant's invention to combine Sommerer's automatic commenting of a failed second address with Creswell's method and apparatus for inspecting an incoming message to a first address and determining if it contains information regarding a second address to retain information that may be utilized in the future, thus allow greater user control of the system, for reasons personal to the user such as having the intended recipient not having set up the account at the second address yet, or properly.

Creswell teaches a process for updating (C 4, L 24-30) electronic information in a computer environment (C 2, L 21-34), but does not explicitly teach the steps of marking the second address and prompting the first user to take one or more actions with the second address as claimed in claim **7, 19, and 31**.

Sommerer also teaches the marking of the second address and prompting the first user to take one or more actions with the second address (Paragraph [0036]-[0038]).

Being from the same field of endeavor, automatic updating for purposes of saving a user's time and effort, it would have been obvious to one of ordinary skill at the time of applicant's invention to combine Sommerer's automatic commenting of a failed second address coupled with further user options with Creswell's method and apparatus for inspecting an incoming message to a first address and determining if it contains information regarding a second address to allow greater user control of the system, for reasons personal to the user as above.

Creswell teaches a process for updating (C 4, L 24-30) electronic information in a computer environment (C 2, L 21-34), but does not explicitly teach where the second address is associated with a person who has a plurality of addresses; and said updating comprises the step of: adjusting priorities of the plurality of addresses for the person as claimed in claim **12, 24, and 36**.

Sommerer also teaches wherein the second address is associated with a person who has a plurality of addresses and said updating comprises the step of: adjusting priorities of the plurality of addresses for the person (Claims 10-12)

Being from the same field of endeavor, automatic updating for purposes of saving a user's time and effort, it would have been obvious to one of ordinary skill at the time of applicant's invention to combine Sommerer's prioritization adjusting of a user's plurality of addresses with Creswell's method and apparatus for inspecting an incoming message to a first address and determining if it contains information regarding a second address to increase the likelihood a recipient will be reached at his or her first attempted

address, thus saving processing and network utilization, and thus energy requirements as well as time on the system's behalf.

Claim Rejections - 35 USC § 103

6. Claims **8, 20, and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Creswell as applied to claim 1 above, and further in view of Berry (US Pre Grant Publication 2003/0131005)

Creswell teaches a process for updating (C 4, L 24-30) electronic information in a computer environment (C 2, L 21-34), but does not explicitly teach wherein said step of updating further comprises the steps of counting a number of messages that indicate the status of the second address and determining whether or not the number of messages is above a threshold, as claimed.

Berry teaches the claimed step of updating further comprises the steps of counting a number of messages that indicate the status of the second address and determining whether or not the number of messages is above a threshold (Paragraph [0042], wherein the search engine index is equivalent to a user's address book, as web URL's are to email messages).

Being from the same field of endeavor, automatic updating for purposes of saving a user's time and effort, it would have been obvious to one of ordinary skill at the time of applicant's invention to combine Berry's method of pruning [or removal] outdated information with Creswell's method and apparatus for inspecting an incoming message to a first address and determining if it contains information regarding a second address

to be as sure as a user's preference of likelihood that outdated information is no longer needed, thus saving space and removing visual [or otherwise] clutter on the message store 22 of Creswell.

Claim Rejections - 35 USC § 103

7. Claims 11, 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creswell as applied to claims 1-2 above, and further in view of Feng et al. (US Pre Grant Publication 2004/0267625, herein referred to as Feng).

Creswell teaches a process for updating (C 4, L 24-30) electronic information in a computer environment (C 2, L 21-34), but does not explicitly teach wherein the record is a portion of an address book of a second user in the database as claimed.

Feng teaches wherein the record is a portion of an address book of a second user in the database (Paragraph [0021]-[0028], wherein someone subscribed to a first user's address book)

Being from the same field of endeavor, automatic address book updating for purposes of saving a user's time and effort, it would have been obvious to one of ordinary skill at the time of applicant's invention to combine Feng's publish subscribe model of address book updating with Creswell's method and apparatus for inspecting an incoming message to a first address and determining if it contains information regarding a second address to allow quick network propagation of all updated addresses, thus having the correct information as soon as it is known, thus not having to wait for the process of updating to execute multiple, redundant times for multiple users.

Allowable Subject Matter

8. Claims 9, 21, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Citation of Pertinent References

The prior art made of record and not relied upon (attached PTO-892 form, E-K) is considered pertinent to applicant's disclosure. It is suggested applicant review the teachings of these references to gain an understanding of the state of the art at the time of applicant's invention.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Caldwell whose telephone number is (571) 272-1942. The examiner can normally be reached on Mon-Fri 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2129

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Caldwell

Examiner

Art Unit 2129

May 24th, 2006

SA


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SUPERVISORY PATENT EXAMINER